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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80528-9599

EXAMINER

HARLE, JENNIFER I

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/785,969

Applicant(s)

MEYER ET AL.

Examiner

Jennifer I. Harle

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-24 are pending. Claims 1-24 are rejected.

#### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the sales receipt providing identifying information about the digital images paid for, including thumbnails; the owner of the kiosk has a fee agreement with the owner of the remote storage site must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Lexicography***

After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicant(s) to be their own lexicographer and to define a claim term to have a meaning other than its ordinary and accustomed meaning. Therefore, the Examiner starts with the presumption that all claim limitations are given their ordinary and accustomed meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001)(“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a “heavy presumption that a claim

Art Unit: 3627

term carries its ordinary and customary meaning.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).<sup>1</sup>

In accordance with the ordinary and accustom meaning presumption, during examination the claims are interpreted with their “broadest reasonable interpretation . . . .” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>2</sup>

However, if Applicant(s) wish to use lexicography and desire a claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests Applicant(s) in their next response to expressly indicate<sup>3</sup> the claim limitation at issue<sup>4</sup> and to show where in the specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to

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<sup>1</sup> It is the Examiner’s position that “plain meaning” and “ordinary and accustom meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

<sup>2</sup> See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

<sup>3</sup> “Absent an *express intent* to impart a novel meaning, terms in a claim are to be given their ordinary and accustomed meaning. [Emphasis added.]” *Wenger Manufacturing Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1232, 57 USPQ2d 1679, 1684 (Fed. Cir. 2001) (citations and quotations omitted). “In the absence of an *express intent* to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning. We indulge a heavy presumption that a claim term carries its ordinary and customary meaning. [Emphasis added.]” *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002) (citations and quotations omitted).

<sup>4</sup> “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope must, at the very least, point to a term or terms in the claim with which to draw in those statements.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

Art Unit: 3627

put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term”).<sup>5</sup> The Examiner cautions that no new matter is allowed.

Failure by Applicant(s) in their next response to address this issue or to be non-responsive to this issue entirely will be considered a desire by Applicant(s) to forgo lexicography in this application and to continue having the claims interpreted with their ordinary and accustomed meaning and with their broadest reasonable interpretation. Additionally, it is the Examiner's position that above requirements are reasonable.<sup>6</sup> Applicant(s) are also cautioned that even though claim interpretation begins with this presumption, after issuance the prosecution history may further limit claim scope if Applicant(s) disclaim or disavow a particular interpretation of the claims during prosecution. *Abbott Laboratories v. TorPharm Inc.*, 300 F.3d 1367, 1372, 63 USPQ2d 1929, 1931 (Fed. Cir. 2002). Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles apply to all examined claims currently pending.

Applicant uses the phrase “performing a point-of-sale transaction” and as set forth in applicant's specification it is not limited to utilizing a point-of-sale terminal. Specification, pg. 34 [0034]. It would encompass any financial transaction charged to a consumer through a web site where the digital images could be uploaded to the Internet through a personal computer as

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<sup>5</sup> See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”). See also MPEP §2111.02, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology.”

<sup>6</sup> The requirements are reasonable on at least two separate and independent grounds: first, the Examiner's requirements are simply an express request for clarification of how Applicant(s) intend their claims to be interpreted. Second, the requirements are reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21<sup>st</sup> Century Strategic Plan, June 3, 2002 available at [www.uspto.gov/web/offices/com/strat2001/index.htm](http://www.uspto.gov/web/offices/com/strat2001/index.htm).

the remote web site could perform the point-of-sale transaction with the credit card/billing information already pre-stored or submitted at registration.

***Claim Rejections - 35 USC § 112***

Although Applicant(s) use “means for” in the claim(s) (e.g. claims 15-17), it is the Examiner’s position that the “means for” phrase(s) do not invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. If Applicant(s) concur, the Examiner respectfully requests Applicant(s) to either amend the claim(s) to remove all instances of “means for” from the claim(s), or to explicitly state on the record why 35 U.S.C. 112 6<sup>th</sup> paragraph should not be invoked.

Alternatively, if Applicant(s) desire to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph, the Examiner respectfully requests Applicant(s) to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. 112 6<sup>th</sup> paragraph, the “means for” phrase(s) will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6th Paragraph*.<sup>7</sup>

Failure by Applicant(s) to address the 35 U.S.C. 112 6<sup>th</sup> paragraph issues in the manner set forth above or to be non-responsive to this issue entirely will be considered a desire by Applicant(s) NOT to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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<sup>7</sup> Federal Register Vol. 65, No 120, June 21, 2000.

Art Unit: 3627

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 8-10, 13-16, 18, and 24 are rejected under 35 U.S.C. 102(a) as being anticipated by [www.photonet.com](http://www.photonet.com) (archived March 2, 2000).

Photonet.com teaches a method or receiving a least one digital image from memory of an imaging device (Site Map, Manage, pg. 1 - uploading photos from your digital cameral or PC), performing a point-of sale transaction for storing a least one digital image at a remote site (How It Works, pg. 1 – digital cameral owners can also upload pictures order high quality photos – just create a free account and purchase a “roll” of spaces on the site, then upload your photos; Help, pg. 6, 8 – I already have digital pictures from my digital camera ...purchase a “roll” of storage space on the site or add a few empty space to a roll currently in your account, if you would like to extend the time you can do by buying more time before the roll expires; Site Map, Manager, pg. 1 Buy New Roll and Add Spaces – so you can upload a whole roll or just a few digital pictures you already have). Uploading is done via the Internet as this is an Internet site and can be done from your PC or digital camera and includes image storage web site on the Internet and inherently contains a server (Site Map, Manage, pg. 1 – upload your photos from your digital camera or PC and How It Works – Kodak PhotoNet online web site).<sup>8</sup> In order for the image to be received from a digital camera it would have to be stored in some form of memory in the

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<sup>8</sup> See e.g. Preston Gralla, How The Internet Works, Millennium Edition, Part 2, The Internet's Underlying Architecture, Chapter 9 The Internet's Client/Server Architecture, August 1999, pp. 42-43 which explains that the host computer houses the Web site and the Web server software enables the host to locate a request web page and return it to the client. Further, Databases and other similar applications on the host computer are accessed and controlled through a common gateway interface (CGI) and send it for further processing to a separate, dedicated database server of application for processing via the CGI. In this instance as data is being stored on the Internet a server would be involved as a server is simply a computer or program that response to commands from a client.

Art Unit: 3627

digital camera, whether internal or removable. PhotoNet.com further teaches that the digital image that was captured and stored can be accessed (Site Map, pg. 1 – View and Share, Shop, Play, and Manage).

As per claims 15 and 16, the following means are equivalent to the descriptions set forth in the reference.

Means for receiving digital images from imaging device memory (Site Map, Manage pg. 1 - upload photos from your digital camera or PC to available spaces)

Means for performing point-of-sale transactions for storing at least some of the images at a remote site (equivalent to second part of claim 1; How It Works, pg. 1 – digital camera owners can also upload pictures order high quality photos – just create a free account and purchase a “roll” of spaces on the site, then upload your photos; Help, pg. 6, 8 – I already have digital pictures from my digital camera ...purchase a “roll” of storage space on the site or add a few empty space to a roll currently in your account, if you would like to extend the time you can do by buying more time before the roll expires; Site Map, Manager, pg. 1 Buy New Roll and Add Spaces – so you can upload a whole roll or just a few digital pictures you already have; as it is not stored in your camera or PC it is remote).

Means for electronically transmitting paid-for images to the remote web site (equivalent to claim 3; Site Map, Manage, pg. 1 – upload your photos from your digital camera or PC, it is electronic as it is sent over the Internet).

Photonet.com teaches an article for a machine having a processor (CPU for the server/web site) and an interface (the software on the website that enables a program to work with the user (the user interface, which can be, a command-line interface, menu-driven, or a



graphical user interface), with another program such as the operating system or the computer's hardware), the article comprising:

Computer memory (server); and

A program encoded in the computer memory, the program, when executed, instructing the processor to receive digital images via the interface, determine a price for storing the digital images at a remote site, process payment information, and send paid-for digital images to the remote site (how the web site operates as set forth in the method, it could not operate without a computer program encoded into the computer memory). Thus, the article for manufacture is rejected for the reasons set forth in the method claims and the explanation set forth above.

Claims 1-3, 7-11, 13-16, 18 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Shiota, et al. (2002/0032909).

Shiota teaches a method of receiving a least one digital image from memory of an imaging device (Abstract, [0012] including a digital camera where the image data is received by reading by reading memory that has been removed from the camera), performing a point-of sale transaction for storing a least one digital image at a remote site ([0041]-[0050] the uploading is done to a remote site the image server). Uploading can be done via the Internet and the remote storage site would include an image storage web site (See Fig. 1; [0017]; [0023]; [0040]-[0041] – would require an image storage web site as the request to the image server is directly connected through a personal computer/PDA via a communication channel). The transaction is carried out at a kiosk (Fig. 2). Shiota further teaches that the digital image is accessed by removing memory from the imaging device and inserting the memory into a memory reader (Fig. 2; [0012]).

Art Unit: 3627

As per claims 15 and 16, the following means are equivalent to the descriptions set forth in the reference.

Means for receiving digital images from imaging device memory (equivalent to first part of claim 1; Abstract, [0012] including a digital camera where the image data is received by reading by reading memory that has been removed from the camera)

Means for performing point-of-sale transactions for storing at least some of the images at a remote site (equivalent to second part of claim 1; ([0041]-[0050] the uploading is done to a remote site the image server as it is not stored in your camera or PC it is remote).

Means for electronically transmitting paid-for images to the remote web site (equivalent to claim 3; ([0041]-[0050] the uploading is done to a remote site the image server; See Fig. 1; [0017]; [0023]; transfer includes docking station, modem, transceiver, cable telephone line – all electronic forms).

Shiota, et al. teaches an article for a machine having a processor (CPU for the server) and an interface (the software on the website that enables a program to work with the user/input device (the user interface, which can be, a command-line interface, menu-driven, or a graphical user interface), with another program such as the operating system or the computer's hardware), the article comprising:

Computer memory (server); and

A program encoded in the computer memory, the program, when executed, instructing the processor to receive digital images via the interface, determine a price for storing the digital images at a remote site, process payment information, and send paid-for digital images to the remote site (how the web site operates as set forth in the method, it could not operate without a

Art Unit: 3627

computer program encoded into the computer memory). Thus, the article for manufacture is rejected for the reasons set forth in the method claims and the explanation set forth above.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7-11, 13-16, 18, 19-21, and 24 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bidun (WO 200163518 A2).

Bidun teaches a method of receiving a least one digital image from memory of an imaging device (entire patent, see specifically, Fig. 16; Abstract, pp. 20-21, lines 5-5 and pp. 24-25, lines 9-21 including a digital camera where the image data is received by reading by reading memory that has been removed from the camera), performing a point-of sale transaction for storing a least one digital image at a remote site (entire patent, see specifically, Fig. 16; Abstract, pp. 20-21, lines 5-5 and pp. 24-25, lines 9-21 the uploading is done to a remote site including a server or a web site). Uploading can be done via the Internet and the remote storage site would include an image storage web site (Fig. 16; Abstract, pp. 20-21, lines 5-5 and pp. 24-25, lines 9-21). The transaction is carried out at a kiosk/minikiosk (entire patent, see specifically, Fig.2; Fig. 16; Abstract, pp. 7-8, lines 15-13, pp. 20-21, lines 5-5 and pp. 24-25, lines 9-21 – the minikiosk is the same as the mobile kiosk). Bidun teaches allowing the digital image to be accessed and conducting a point-of-sale transaction for storing the digital image at a remote site (entire patent, see specifically, Fig. 16; Abstract, pp. 20-21, lines 5-5 and pp. 24-25, lines 9-21 the uploading is

Art Unit: 3627

done to a remote site including a server<sup>9</sup> or a web site and pp. 21-22, lines 23-14; teach that the images can be uploaded to a web site for a fee and teaches that the web content can be browsed, as the images can be uploaded to a web site or transferred into different media such as mugs and tee-shirts the images could be accessed after capture at a remote site, even if the remote site is only the kiosk). Bidun teaches that the digital images are accessed by removing the memory from the imaging device and inserting the memory into a reader for the same reasons set forth above (entire patent, see specifically, Fig. 16; Abstract, pp. 20-21, lines 5-5 and pp. 24-25, lines 9-21 including a digital camera where the image data is received by reading by reading memory that has been removed from the camera).

As per claims 15 and 16, the following means are equivalent to the descriptions set forth in the reference.

Means for receiving digital images from imaging device memory (equivalent to first part of claim 1; including a digital camera where the image data is received by reading by reading memory that has been removed from the camera)

Means for performing point-of-sale transactions for storing at least some of the images at a remote site (equivalent to second part of claim 1; the uploading is done to a remote site the server/web site as it is not stored in your camera or PC it is remote).

Means for electronically transmitting paid-for images to the remote web site (equivalent to claim 3; (the uploading is done to a remote site the server/web site; transfer includes wireless, radio, cable, modem, transceiver, telephone line – all electronic forms).

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<sup>9</sup> Id.

Art Unit: 3627

Bidun teaches an article for a machine having a processor (CPU for the server) and an interface (the software on the website that enables a program to work with the user/input device (the user interface, which can be, a command-line interface, menu-driven, or a graphical user interface), with another program such as the operating system or the computer's hardware), the article comprising:

Computer memory (server); and

A program encoded in the computer memory, the program, when executed, instructing the processor to receive digital images via the interface, determine a price for storing the digital images at a remote site, process payment information, and send paid-for digital images to the remote site (how the web site operates as set forth in the method, it could not operate without a computer program encoded into the computer memory). Thus, the article for manufacture is rejected for the reasons set forth in the method claims and the explanation set forth above.

The examiner sets forth that a 102(e) rejection is appropriate and that a 103(a) rejection is unnecessary as this is a kiosk system. As a kiosk system, it is by nature going to have a set of options within a vending system that would utilize a plurality of choices for a consumer.

Assuming *arguendo*, that the kiosk system of Bidun sets forth small genus which places a claimed species in the possession of the public as in *In re Schaumann*, 572 F.2d 312, 197 USPQ 5 (CCPA 1978), the species would have been obvious because the genus was sufficiently small to justify a rejection under 35 U.S.C. 102. Moreover, the following claims are specifically set forth under 35 USC 103(a).

As per claims 7 and 14 Bidun teaches that at least one digital image is received by reading memory that has been removed from the imaging device (pg. 24, lines 9-14 and

Art Unit: 3627

pg. 25, lines 1-8). There are two well-known mechanisms by which a digital image can be stored in a digital camera, internal memory and removable memory. Internal memory is limited in the amount of data, which can be stored without deleting any images. Removable memory is still limited in the amount of images, which can be stored. However, the memory can be removed and additional memory can be purchased. Even with this benefit, the cost of this memory is much more expensive than the cost of average film or downloading of the images. Additionally, Bidun teaches that conventional digital capture devices typically include a limited internal memory unit for storage of digital photos or videos and that the compact nature of the device also generally limits the space allocated for internal memory so that once the stored data fills allocated space the digital information must be uploaded and erased or the entire memory unit must be replaced in order to store additional data. Pg. 1, lines 7-11. Moreover, Bidun teaches that removing a filled memory unit from the device for later processing is inconvenient and can result in the loss of the memory unit and stored data. Pg. 2, lines 1-4. He further teaches that obtaining additional memory units to replace filled memory units requires the user to purchase and transport multiple memory units, which may be cumbersome and expensive. Id. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included the well-known step of receiving and accessing at least one digital image by reading memory that had been removed from the digital imaging device as already taught in Bidun for the purpose of being able to have the ability to access all types of digital cameras and thus be able to service all customers at the kiosk thereby maximizing revenues and profits.

Claims 19-21 are rejected for the same reasons set forth in the method claim above.

As per claims 8 and 9, Bidun teaches that the remote site is a server/image storage web site (pg. 11, lines 3-5, pg. 20, lines 21-23). Bidun teaches that storing digital images takes up space and that the uploading of the stored information directly to a personal computer required the availability of such a computer when using the capture device can be cumbersome or inconvenient. Additionally, Bidun teaches that convention digital capture devices typically include a limited internal memory unit for storage of digital photos or videos and that the compact nature of the device also generally limits the space allocated for internal memory so that once the stored data fills allocated space the digital information must be uploaded and erased or the entire memory unit must be replaced in order to store additional data. Pg. 1, lines 7-11. Moreover, Bidun teaches that removing a filled memory unit from the device for later processing is inconvenient and can result in the loss of the memory unit and stored data. Pg. 2, lines 1-4. He further teaches that obtaining additional memory units to replace filled memory units requires the user to purchase and transport multiple memory units, which may be cumbersome and expensive. Id. Thus, Bidun teaches that several of the objects of his invention are fulfilled by a multi-functional kiosk apparatus that permit gathering and/or transmitting data to a desired remote location. Pg. 2-3, lines 14-5. Image storage web sites are connected to a remote server were well-known in the art for just these purposes, i.e. Photonet.com, Shutterfly.com, Fujifilm.net, clubphoto.com, photoaccess.com and Applicant's own site cartoga.com, among many others. It would have been obvious to

Art Unit: 3627

one having ordinary skill in the art at the time of the invention to have utilized a remote site of an image storage web site, which would have incorporated a server<sup>10</sup> as already taught in Bidun because the skilled artisan would have recognized that this business practice accrues the advantages explicitly taught by Bidun.

Claims 4, 5, 17, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al. or Bidun in view of [www.telepix.com](http://www.telepix.com) and further in view of Michael Meyer, Dialing for Dmarks: [Atlantic Edition] Newsweek, January 12, 1998, pg. 8 and Chet Dembeck, A Technological Tale, Mom and Pops Splurge on '90s Gadgetry and Hope for a Storybook Ending, Washington Business Journal, August 17, 1998.

Shiota, et al. or Bidun teach as set forth above. However, Shiota nor Bidun teach printing a sales receipt for the transaction identifying information about the digital images that were paid for. [www.telexpix.com](http://www.telexpix.com) teaches receiving at least one digital image from memory of an imaging device, storing at least one digital image at a remote site (image storage web site) and allowing it to be accessed, uploading digital images to the remote site via the internet from a wide variety of digital camera memory cards, printing a sales receipt for transactions that occur at the kiosk (PhotoStation 2000 – automatic job order logging and receipt printing). [www.telepix.com](http://www.telepix.com) further teaches that the kiosk is a mini-kiosk (has a memory card reader – external compact flash, smart media, PCMCIA card reader), a processor responsive to the card reader and programmed to perform a point-of sale transaction and sends digital images to a remote storage site (400 MHz AMD K6 processor - automatic job order logging and receipt printing; internet connectivity to Telepix Photo Network – display, share, download, email and print), a data communication

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<sup>10</sup> Id.



Art Unit: 3627

device responsive to the processor for sending the digital images to the remote site (Integrated 10/100 Ethernet network port, Dual Universal Serial Bus, Supports dial-up, ISDN, ADSL or cable modem connectivity), at least one device, coupled to the processor, for entering payment information (wireless infrared keyboard for enhanced security in setup and administration, easy to use touch screen user interface), a receipt printer coupled to the processor, whereby the processor can command the printer to print out receipts of the transactions (receipt printing). However, [www.telepix.com](http://www.telepix.com) does not teach that a point-of-sale transaction is performed for storing at least one digital image at a remote site. Meyer teaches that Americans take itemized bills for granted. Dembeck teaches that customers did not like the fact that receipts were not itemized and that merchants found it a small price to pay to keep customers happy. Itemization provides consumers with information, for example, of proof of purchase, for tax purposes, for disputes over charges/payment, and informs the customer exactly what goods/services were purchased. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of providing a printed sales receipt through a printer in the mini-kiosk as taught in [www.telepix.com](http://www.telepix.com) in the method of Shiota or Bidun as this business practice provides the customer with necessary information, saves time spent by a customer in making purchases, enhances customer satisfaction and entices customers to stay with the business. Moreover, it would have been obvious to one having ordinary skill in the art at the time of the invention to have added identifying information about the digital images that were paid for to the receipt for the reasons set forth above.

Claims 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al. or Bidun in view of [www.telepix.com](http://www.telepix.com) and in view of Michael Meyer, Dialing for Dmarks:

Art Unit: 3627

[Atlantic Edition] Newsweek, January 12, 1998, pg. 8 and Chet Dembeck, A Technological Tale, Mom and Pops Splurge on '90s Gadgetry and Hope for a Storybook Ending, Washington Business Journal, August 17, 1998 as applied to claims 1 and 4-5 and 19 and 22 above, and further in view of Bill Baird, The E-Marketer's Swipe File: Cutting-Edge Intelligence for the New Economy, Target Marketing, Vol. 23, No. 12, December 2000, pg. 20/ Jill Welch, Craving the latest and the Greatest? Try the Advanced Photo System, Vol. 18, Issue 45, November 4, 1996, pg. 91/Perfect Prints, Time, November 3, 1997, pg. 75/ Iomega and Lexmark Deliver Industry's First PC-Free Digital Photo Processing Solution, Business Wire October 6, 1998, pg. 1.

As previously set forth above from the combined teachings, it is obvious to provide a sales receipt with identifying information for which the digital images were paid. Baird teaches that an e-marketer's order form had added thumbnail product photos to its order form to reduce the rate of abandoned sales. Welch/Time teaches that thumbnails have been included with processed film in order to increase the safety of the negatives and to make it easier to order reprints. This would translate into digitally saved pictures on the web as you would have the thumbnails in front of you on the receipt, already identified and would not have to go to the site each time. Business Wire teaches the use of thumbnails in the digital media with the use of photo albums to organize photos in a print catalog for easy retrieval/ printing purposes later on. While this is in the form of a Zip disk, the principal would still apply for a sales receipt for a web site, as it is still a form of remote storage. Additionally, the thumbnails are the best form of itemization that can be provided for images to a consumer/customer as names would not convey the same type of information as the thumbnail. For example, a title, has the potential to refer to

Art Unit: 3627

multiple pictures, whereas the thumbnail, will instantaneously provide the consumer/customer with the correct picture/image for which fees are being paid. Thus, would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of providing a printed sales receipt through a printer in the mini-kiosk utilizing thumbnails for the reasons taught in Baird/Welch/Time/Business Wire in [www.telepix.com](http://www.telepix.com) in the method of Shiota or Bidun as this business practice provides the customer with necessary information, saves time spent by a customer in making purchases, enhances customer satisfaction and entices customers to stay with the business. Moreover, it would have been obvious to one having ordinary skill in the art at the time of the invention to have added identifying information about the digital images that were paid for to the receipt for the additional reasons set forth above.

Claim 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota, et al. or Bidun as applied to claims 1 and 11 above, and further in view of Eastman Kodak: Kodak to acquire 51% state in Picture Vision, M2 Presswire, February 13, 1998, pg. 1.

Shiota and Bidun teach as set forth above. However, neither Shiota nor Bidun teach that the owner of the kiosk has a fee agreement with the owner of the storage site. M2 Presswire teaches that PictureVision built the leading franchise at retail, i.e. digital image storing. Franchising is a form of a fee agreement with an owner of a remote storage site. M2 Presswire further teaches that this form of transaction based processing gives customers more benefits by allowing them to share their photos quickly and easily through the combined service, i.e. retail kiosks and the owned remote storage. Moreover, it is well known in the business art that if one does not own space one pays for it, i.e. rents it, leases it, or buys it. The same is true of a service that one provides to a customer. It would have been obvious to one having ordinary skill in the

Art Unit: 3627

art at the time of the invention to have included the step of having the owner of the kiosk have a fee agreement with the owner of the remote storage site in Shiota or Bidun as taught in M2 Presswire because the skilled artisan would have recognized that this business practice is a mechanism by which the remote storage site stays profitable and stays in business, would follow in the internet world from the business community where competition is sometimes world wide and customers have a greater influence on the success of a business and provides a valuable service to the kiosk owner by avoiding the need for him incur the costs of setting up his own web site for his customers, when he can pay a low fee for a site that is already set up and can be off-set in other negotiated ways through the franchised licensing agreement.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Peltz (6,205,716 B1) discloses a kiosk that incorporates remote storage of digital imaging and administrative document imaging and record keeping.

LaFleur (6,289,326 B1) discloses an electronically interactive portable kiosk that is manufactured in a wide range of sizes and easily movable.

Jebens, et al. (6,332,146 B1) discloses a digital data management and order delivery system that includes uploading digital images, thumbnails, varying reports and invoices.

Frey, et al. (6,369,908 B1) discloses a photo kiosk which can create an electronic image of a user and can transmit the electronic image over the Internet, as well as collect money.

Scott, et al. (6,545,687 B2) discloses a method and apparatus that manipulates thumbnail images used in image-based browsing file management systems and their use for categorization.

Miyatake, et al. (6,466,262 B1) discloses a digital wide camera that can connect to an external storage device with image data structure.

Watanabe, et al. (6,578,072 B2) discloses an order form that contains the equivalents of thumbnails from a browser-like system.

McIntyre, et al. (6,587,839 B1) discloses a method and system for notifying a consumer that the photofinishing order is ready and for controlling inventory of a photofinishing orders in a business including containing at least one image of the plurality of images in the customer order.

Savitzky, et al. (6,571,271 B1) discloses an image server which captures images from a digital camera, including a removable image memory card and download them to a web page that are browsable.

Parulski, et al. (6,573,927 B2) discloses a digital camera that permits viewing images on a removable memory card that can then be inserted in a walk-up kiosk and the images stored in an image album storage.

Hayashi, et al. (6,618,082 B1) discloses digital camera adapted to reproduce an original image and a thumbnail image, including a removable memory card.

Parulski, et al. (2001/0012066 A1) discloses capturing digital images to be transferred to a service provider for storage from an electronic still camera (including a removable memory card and a kiosk) and a receipt for ordered prints.

Smith (2001/0050684 A1) discloses a global lab software system, including a digital camera (including a removable memory card), capturing digital images to transferred to a service provider for storage and a remote kiosk.

Jackson, et al. (2002/0105658 A1) discloses providing a payment schedule for utilizing stored images using a designated date from a plurality of images previously stored by a user in a memory location of a service provider and includes an invoice.

Wasilewski, et al. (2002/0105665 A1) discloses a method of interacting imaging products/services with non-imaging products/services in a single kiosk, includes ability to upload digital images from a digital camera (with removable memory) and payment options and ATM functions.

Shiota, et al. (2002/0013742 A1) discloses a network photograph service system.

Shinkai (2002/0052753) discloses an order acceptance machine that transfers the accepted digital image and order information to an image printer and a voucher printer, which prints a voucher representing the details of a print order including an order and ordered thumbnail images.

Shinkai (JP 2001339557) discloses a printing order receiving system for using in a shop front which prints receipts which contain purchase order content with thumbnail images and information corresponding to the image data.

EP 0 0860 980 A2 discloses a digital camera that permits viewing captured digital images (including a removable memory card) and the ability to create a print order utilization file. The memory card can be inserted in a walk-up kiosk and connected via a wired or wireless link to an image album storage.

Jerry O'Neill, Photofinishers Shoot the Curl in Cyberspace, Net Gains, Photographic Trade News, September, 1996, pg. 1, discloses digital images being sent across the net and small versions being sent back in thumbnail form.

Discoveries, Kodak DC 240: Digital Camera with Conventional Feel, Asia Computer Weekly, July 5, 1999, discloses a digital camera with a removable memory card that at the Kodak Picture Kiosk permits printing of thumbnails and marking pictures for printing and editing as well as transfer of images.

Mike Langberg, Digital Photography Comes into Focus Computer and Film Companies Make Ease of Use a Priority After Realizing Customers Are Confused, San Jose Mercury News, Computing and Personal Tech, March 7, 1999, pg. 1E, teaches AOL's "You've Got Pictures" for storing pictures in digital forms and thumbnails of pictures, as well as for a small fee the ability to download high-resolution copy of an image suitable for printing. Additionally discloses the launch of smart kiosks for downloading digital images from digital cameras in photoshops, pharmacies and similar locations without a computer, including Fuji's Aladdin.

Fujifilm Announces New Fujicolor CD to Complement Company's Online Photoservice-Fujifilm.Net, Business Wire, February 3, 2000, pg. 1268, discloses launching of Fujifilm.New site, which is a powerful, convenient and easy-to-use way for pictures to be stored, viewed and shared online. Fujifilm.Net is supported by their digital minilabs and its network including the kiosks, Aladdin Picture Centers.

HP announce HP Cartogra Photo Internet Infrastructure; Infrastructure and Web Stie make Sharing Images Easy, Fast and Reliable, Business Wire, August 30, 1999, pg. 1, discloses that the web page does not charge for storage.

Electronic Photography News, Vol. 13, Number 10, October 1999, pp. 1-13, discloses about the various Digital Kiosks, Minilabs and Cameras including Telepix, Fujifilm with receipt printer, etc.

Photofinishing News Letter, Vol. 16, Number 12, March 1, 1999, pp. 1-23, discloses the features of Kodak's Picture Maker Kiosk, Gretag/Telepix Kiosk, Kodak/Picture Vision's ventures to add photographs online.

Photofinishing News Letter, Vol. 17, No. 3, October 11, 1999, pp. 1-12, discloses integration of Telepix/Gretag kiosks into various Digital minilab systems and the use of Fuji's Kiosk and Remote input stations with their features.

PictureVision, Inc., and NDS Group Plc Join Forces to Make Sharing Pictures Online as Easy as Watching TV, Business Wire, February 1, 2000, pg. 1, discloses an interactive system between TV, digital photography and the internet for accessing digital pictures stored on Internet sites, including Kodak PhotNet online. Additionally, it discloses that digital camera users should be able to download their own personal photographic images for traditional printing at any one of the 40,000 participating Kodak PhotoNet online retailers worldwide.

How to Share Photos Online, Times Union, Life and Leisure, February 23, 2000, pg. D4, discloses the ability to share photos online if you don't have a digital camera or a scanner through Kodak PhotoNet Online through their 40,000 retailers including Kmart, CVS Pharmacy and Rite Aid. Discusses Storage fees for photos. Also discusses Seattle FilmWorks, Ofoto, PhotoWorks and Wal-Mart. In addition discusses the ability to store digital images that you already have and storage prices.

Susan Kuchinskas, Excite's Photo Center Could Boost Web Visits, Adweek, Vol. 40, Issue 50, December 13, 1999, pg. 91, discusses Excite's web cite which permits upload, download, store, edit and print high-resolution photos from the web-site in conjunction with technology from Hewlett-Packard and Webships.



Bill Husted, share Your Photos on the Web- Free There are Free and Easy Ways t Store Your Photos Using the Internet. And You Don't Need Your own Web Site, Orlando Sentinel, March 11, 2000, pg. E4, discloses various web sites that allow one to upload digital images onto the internet for storage with and without payment.

John Larish, Onsite and Online Pixel Magic Imaging, The Photo Retailer's Formula to Digital Imaging Success, International Contact, October/November 2000, pp. 60-61, discloses digital imaging kiosks that are part of a suite of technology solutions marrying online image processing and fulfillment with photo retailers nationwide. They allow uploading and emailing of images through the internet.

Donna Rogers Kanich, Kiosk Fever, eDigitalPhoto, July/August 2001, teaches that photo kiosks are not new but that new models are coming out. Talks about fees and receipts associated with uploading but does not talk about when these fees were started. Does talk about new features that are coming.

In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, and because "the continual, chief complaint of inventors and their lawyers: that patent examiners are abysmal communicators, both orally and in writing,"<sup>11</sup> the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicant(s) with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. If Applicant(s) disagree with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or

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<sup>11</sup> Sabra Chartrand, *A Bid to Overcome Patent Backlogs*, 152 N.Y. Times C2 (Sept. 23, 2002).

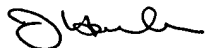
Art Unit: 3627

implied,<sup>12</sup> the Examiner respectfully requests Applicant(s) *in their next response* to expressly traverse the Examiner's position and provide appropriate arguments in support thereof. Failure by Applicant(s) *in their next response* to traverse the Examiner's positions and provide appropriate arguments in support thereof will be considered an admission by Applicant(s) of the factual determinations and legal conclusion not expressly traversed.<sup>13</sup> By addressing these issues now, matters where the Examiner and Applicant(s) agree can be eliminated allowing the Examiner and Applicant(s) to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is 703.306.2906. The examiner can normally be reached on Monday through Thursday, 6:30 am to 5:00 pm,.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703.308.5183. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1113.



Jennifer Ione Harle  
Art Unit 3627

October 19, 2003

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<sup>12</sup> E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

<sup>13</sup> See also MPEP §714.02, 37 CFR §1.111(b), and 37 CFR §1.104(c)(3).

Application/Control Number: 09/785,969  
Art Unit: 3627

Page 26